

REMARKS

Status of the Claims

Claims 2-6 are currently pending in the application. Claims 2-6 stand rejected. Claims 5 and 6 have been amended as set forth herein. All cancellations and amendments are made without prejudice or disclaimer. No new matter has been added by way of the present amendments. Specifically, the amendment to claims 5 and 6 is supported by the specification at page 10, line 4 to page 12, line 10 and at Table 4 at page 36. Reconsideration is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 2-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki et al., EP 0791688 (hereinafter referred to as "Yamazaki et al."). (*See*, Office Action of September 29, 2005, at page 2, hereinafter referred to as "Office Action"). Applicants traverse the rejection as hereinafter set forth.

M.P.E.P. § 706.02(j) sets forth the standard for an obviousness rejection as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 5, as amended, recites, a “wrapper paper for a smoking article, which decreases an amount of visible sidestream smoke of tobacco, the wrapper paper containing: at least 30 g/m² of calcium carbonate, and at least 3% by mass of a burn adjusting agent, wherein an ash content in a surface layer on at least one side of the wrapper paper is not higher than 35% by mass, and wherein the ash content in the surface layer is lower than a total ash content of the paper.” Claim 6, as amended, likewise recites, in part, “wherein the ash content in the surface layer is lower than a total ash content of the paper.” The as-filed Specification discloses a detailed explanation of the importance, advantages and usefulness of the ash content in the surface layer of the presently claimed invention at page 10, line 4 to page 12, line 10 and at Table 4 at page 36.

Yamazaki et al. do not disclose the limitation “wherein the ash content in the surface layer is lower than a total ash content of the paper.” Thus, the presently claimed invention is not obvious over Yamazaki et al. because to “establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP §2143.03.

Dependent claims 2-4 are non-obvious, *inter alia*, as depending from a non-obvious base claims, claims 5 and 6.

Reconsideration and withdrawal of the obviousness rejection of claims 2-6 are requested.

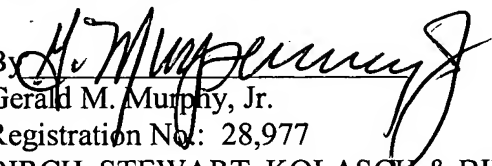
CONCLUSION

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: February 28, 2006

Respectfully submitted,

By 
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